

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-3 and 8-16.

The following claims are *independent*: 1, 8, and 11.

The following claims have previously been *withdrawn*: 4-7.

Please *amend* claims 1, 8, and 11; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 101

The Office Action has rejected claims 1, 8, and 11 under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Applicant respectfully traverses this rejection. Applicant submits that the elements recited in the claims are, in fact, directed to statutory subject matter. Though Applicant respectfully traverses the Examiner's rejection and reserves the right to argue patentability of the claims in their

original form at a later time, Applicant has amended independent claims 1, 8, and 11 to provide clarification and/or to better track business practices. Accordingly, for at least these reasons, Applicant submits that claims 1, 8, and 11 are directed to statutory subject matter and withdrawal of this ground of rejections is requested.

Claim Rejections - 35 U.S.C. § 112

The Office Action rejected claims 1, 8, and 11 under 35 U.S.C. §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses this rejection. Though Applicant respectfully traverses the Examiner's rejection and reserves the right to argue patentability of the claims in their original form at a later time, Applicant has amended independent claims 1, 8, and 11 to provide clarification and/or to better track business practices. Accordingly, Applicant requests: withdrawal of this ground of rejection(s), and reconsideration and allowance of the claims.

Claim Rejections - 35 U.S.C. § 102

The Office Action rejected claim(s) 1-3 and 8-16 under 35 U.S.C. § 102(a) as anticipated by May, US Patent No. 6,317,727 (hereinafter "May").

Applicant respectfully traverses the rejection and submits that a showing of anticipation has not been made and that May does not discuss every element of the noted claims.

Applicant submits May does not discuss or render obvious at least the following element(s) as recited, *inter alia*, in independent claims 1 and 8:

...
receive a template for screening said received data identifying said
at least a first reference obligation...screen said received data
according to the received template identifying said reference
entity for accuracy

...
The Office Action asserts the above claimed elements are shown in May (Figure 25,
item 512) and alleges:

wherein it is understood that the order date is being entered into a
template that was received by the system at an earlier
date...wherein it is understood that the information MUST be
accurate for the order to be legal and proper accordingly it must
be screened for accuracy... (Office Action, p. 4)

Applicant disagrees with the Examiner's characterization of the cited reference and
traverses the assertions made by the Examiner.

In direct contrast to the Examiner's assertions, Applicant submits that May essentially
discusses *database for static screen data entry*. Applicant notes that May discusses:

With reference to FIG. 22A, the auction interface 430 includes a
queued orders window 432 into which the user enters an order,
and a submitted orders window 434 which shows the orders
submitted to the auction mechanism 34 via the auction module
81t. Orders can be added via the Add button 436. Orders are
moved from the queued orders window 432 to the submitted
orders window 434 by highlighting the order and then selecting the
Submit button 438...

(May, Col. 42, lines 1-8)

...Preferably, a relational database 66 resides on the hard disk 64
for maintaining information such as current state information for

each trader workstations 20, user and business unit data, financial instrument definitions, order states, transaction states, confirmation states, historical confirmation and transaction data, credit preferences of all business units, and historical market data. Preferably, the relational database 66 is based on structured query language (SQL) management system, as well known in the industry.

(May, col. 12, line to col.13, line 5)

These portions of May just describe static screens or static interfaces that help users in entering order data or setting predefined preferences. These portions shows a clear lack of receiving a template corresponding to a particular type of trade, as the user must enter the order details in a static screen, providing no discussion of a template. Further, these static data entry screens were created as part of a database and never received. May just discusses data entry, where receipt of any data does not adapt the static screen for a reference entity or a reference obligation. Therefore, May does not teach or suggest "**receive[ing] a template for screening...**" or "**screen[ing] said received data...**," let alone to "**receive a template** for screening said received data identifying said at least a first reference obligation...screen said received data according to **the received template identifying said reference entity for accuracy**" as recited in claims 1 and 8. (Emphasis added).

Further, Applicant notes that the portions of May cited in the Office Action just discuss a symbol being used as an abbreviation for a financial instrument and do not disclose or suggest the above discussed elements as recited claims 1 and 8. Accordingly, Applicant submits that May's *database for static screen data entry* is different from at least claims 1 and 8. For at least the reasons discussed above, Applicant submits that the pending rejection

has mischaracterized the language of the claim element and/or the applied reference and, thus, has not established a case of anticipation.

Further, Applicant submits that the Examiner has merely asserted "it is understood that the order date is being entered into a template that was received by the system at an earlier date...wherein it is understood that the information **MUST** be accurate for the order to be legal and proper accordingly it must be screened for accuracy." (Office Action, p. 4) Applicant respectfully disagrees and submits the Examiner has not cited any reference or taken Official Notice. Applicant submits that, by making general allegations without citing to applied references or taking Official Notice, the pending rejection has necessarily relied on knowledge gleaned only from Applicants' disclosure. Applicant submits it is clearly **not** understood that the information must be accurate for the order to be legal and proper. Traders are capable of and clearly have and will continue to enter inaccurate information into order forms and generate unintended and unverified orders. There have been many noteworthy examples where trading houses have been obligated to fulfill and back erroneous orders. It is further **not** "understood that that the information **MUST** be accurate for the order to be legal and proper accordingly it must be screened for accuracy" because traders and trading houses have and are capable of carrying out illegal and improper transactions. Unfortunately, there have been many notorious examples of this as well.

Therefore, the assertions made in the Office Action are unsubstantiated. Should the Examiner maintain the rejection, Applicant respectfully requests that he cite to a reference or take Official Notice and provide additional clarification as to how and specifically why the Examiner believes "it is understood that the order date is being entered into a template that

was received by the system at an earlier date...wherein it is understood that the information MUST be accurate for the order to be legal and proper accordingly it must be screened for accuracy.”

Accordingly, Applicant submits that a showing of anticipation has not been established and respectfully requests reconsideration and withdrawal of this basis of rejection and allowance of the claims. Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific citations and explanations describing how each and every element of the pending claims are allegedly anticipated by the cited reference, providing indications of specific, alleged correspondences between claim elements and cited portions of the applied reference. Because the pending rejection has not established a *prima facie* case of anticipation by neglecting and/or mischaracterizing claim elements and because the applied reference does not discuss or render obvious at least the claim elements discussed above, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection.

Although of different scope than independent claims 1 and 8, Applicant submits that independent claim 11 is patentably distinct from May for at least similar reasons to those discussed above identifying deficiencies in the cited reference with respect to independent claims 1 and 8. Further, each of claims 2-3, 9-10, and 12-16 are different in scope, Applicant submits that each of these claims is also patentable over the cited reference(s) for at least similar reasons as discussed above. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection and allowance of the claims (and as a consequence any claims depending therefrom).

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 1-3 and 8-16 under 35 U.S.C. § 103(a) as being unpatentable over May, US Patent No. 6,317,727 (hereinafter “May”), and in further view of Clark et al., US Patent No. 5,890,140 (hereinafter “Clark”).

Applicant respectfully traverses these rejections and submits that a *prima facie* showing of obviousness has not been made and that the applied references, taken alone or in combination, fail to discuss or render obvious every element of each noted claim(s).

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);
- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. (MPEP § 706.02(j))

Applicant submits that the rejections in the pending Office Action do not establish at least requirement(s) (A) (B) and (D) of a *prima facie* showing of obviousness.

Applicant submits May or Clark, alone or in combination, do not discuss or render obvious at least the following element(s) as recited, *inter alia*, in independent claim 1:

...
receive a template for screening said received data identifying said
at least a first reference obligation...screen said received data
according to the received template identifying said reference
entity for accuracy
...

The Office Action refers to section 5 of the Office Action, to assert where the above claimed elements are allegedly disclosed in May. Applicant disagrees with the Examiner's characterization of the cited reference for at least the reasons discussed above in connection with the 35 U.S.C. § 102(a) rejection. Further, the Office Action asserts the above claimed elements are shown in Clark "for the reasons set forth in section 8 of the previous office action mailed 2/4/2009." (Office Action, p. 7). The Office Action mailed on February 4, 2009 alleges "[I]f applicant is of the opinion that May does not disclose verifying or screening data for accuracy, then resort may be had to Clark et al. to show it is old and well known to do so at various points in a financial transaction sequence." (Office Action, February 4, 2009, p. 7). Applicant submits that Clark fails to remedy the deficiencies of May as discussed above in connection with the 35 U.S.C. § 102(a) rejection. Clark or May, taken alone or in combination, among other limitations, do not disclose or suggest "receive a template for screening said received data identifying said at least a first reference obligation...screen said received data according to the received template identifying said reference entity for accuracy" as recited within the context of claim 1 and a *prima facie* case of obviousness has not been established.

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," (§ 2106 II(C), emphasis added) and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider "every limitation in the claim" and "[a]ll words in [the] claim" in judging the

patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s).

Accordingly, by neglecting and/or mischaracterizing claim elements, Applicant submits that a *prima facie* showing of obviousness has not been established and thus the applied reference(s) do not discuss or render obvious at least these claimed elements. As such, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection and allowance of the claim(s). Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific citations and explanations describing how each and every element of the pending claims are allegedly rendered obvious by the cited reference, providing indications of specific, alleged correspondences between claim elements and cited portions of the applied reference.

Further, the Office Action states that at:

...the time of the invention it would have been obvious to one of the ordinary skill in the art to modify the system and method of May to include error checking or verifying or screening the inputted data for accuracy for the benefits thereof...it is obvious to check ones work to eliminate/minimize errors during the input of data...it is notorious old and well known for financial instruments to be verified accurate...

(Office Action, February 4, 2009, page 7).

Applicant submits that the Examiner has asserted:

...it is understood that the order date is being entered into a template that was received by the system at an earlier date...wherein it is understood that the information MUST be accurate for the order to be legal and proper accordingly it must be screened for accuracy.

(Office Action, page 4).

Applicant respectfully disagrees and submits that the Examiner has failed to take Official Notice as discussed above in connection with the 35 U.S.C. § 102(a) rejection. Applicant submits it is clear that it is not understood that the information must be accurate for the order to be legal and proper. To properly support such assertions of obviousness the Examiner must (a) provide evidentiary support, (MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill."); (b) establish the appropriate indication of ordinary skill in the art (MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill."); and (c) provide an objective rationale for modifying and/or using the applied references and/or the official notice.

(a) Evidentiary Support. Applicant submits that the Examiner fails to provide explicit evidentiary support as to why the relevant claim elements of the noted claims would be allegedly old and notorious to one of ordinary skill in the art at the time the invention was made. Per MPEP § 2144.03-A, "[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." (Emphasis original). Applicant respectfully submits that the Examiner fails to provide explicit evidentiary support as to why "it would have been obvious to one of the ordinary skill in the art to modify the system and method of May to include error checking or verifying or screening the inputted data for accuracy for the benefits thereof" as required by the MPEP.

(b) Indication of the level of ordinary skill. In addition to the aforementioned lack of evidentiary support, Applicant further submits that impermissible hindsight has been applied in asserting obviousness of the various claim elements without citing prior art or providing an indication of the level of ordinary skill. MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill." The pending rejection asserts "it would have been obvious to one of the ordinary skill in the art to modify the system... (see, e.g., p. 7, Office Action, February 4, 2009, page 7; emphasis original) but has provided no indication or discussion of which art is described or the level of ordinary skill associated therewith. The rejection's reference to "the art" is overly general and, consequently, does not provide a specific indication of the level of ordinary skill pertinent to the claimed subject matter. MPEP § 2141.03 (III) states, "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." Applicant is unclear as to what exactly the Examiner is alleging with regard to the level of ordinary skill and, thus, is not in a position to provide a complete reply that is most suited to addressing the Examiner's concerns. As no indication of the level or ordinary skill has been provided, Applicant submits that the rejection applies impermissible hindsight and has not made a *prima facie* showing of obviousness. Should the Examiner maintain the rejection and/or take Official Notice, Applicant respectfully requests that he identify the pertinent art, discuss the level of ordinary skill alleged to be associated therewith at the time of the invention, and clarify why he believes the claimed subject matter would have been obvious to one possessing that level of skill.

(c) Objective Rationale. Applicant submits that the pending assertions have not provided sufficient objective rationale for modifying the applied references. By way of example only, Applicant notes that the pending rejection alleges, “it is understood that the order date is being entered into a template that was received by the system at an earlier date...wherein it is understood that the information MUST be accurate ...” (Office Action, p. 4). Applicant respectfully submits that the alleged assertions that it is understood and rationales for the proposed modifications of the applied references provided here and throughout the pending rejection are overly general, which do not point beyond error checking to a modification of itself or a combination with the allegedly obvious “verification.” Applicant is unclear how the Examiner believes it is obvious to one of ordinary skill in the art to modify the general alleged utility just because “it is notorious old and well known for financial instruments to be verified accurate.” Applicant submits that merely citing an alleged utility of a reference’s own system, without providing any attendant explanation or articulation of how that alleged utility points beyond the reference to the modifications of the references proposed in the pending rejection, is insufficient to support an assertion of obviousness under 35 U.S.C. § 103. MPEP §2141 (III) states, *inter alia*, “The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious,” and that, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Applicant submits that, by merely quoting alleged rationales of the applied references, the pending rejection has failed to provide a “clear articulation of the reason(s)” or an “articulated reasoning with some rational underpinning” for the proposed modifications of the references.

Applicant further requests that the Examiner clarify exactly why he believes the specific modifications, taken in relation to the claims as wholes, would allegedly have been obvious to one of ordinary skill in the art at the time the invention was made.

As such Applicant submits that a *prima facie* showing of obviousness has not been made and respectfully request reconsideration and withdrawal of the pending rejections. Should the Examiner maintain the rejection, Applicant respectfully requests that he cite to a reference or take Official Notice and provide additional clarification as to how and specifically why the Examiner believes "it is understood that the order date is being entered into a template that was received by the system at an earlier date...wherein it is understood that the information MUST be accurate for the order to be legal and proper accordingly it must be screened for accuracy."

Although of different scope than claim 1, Applicant submits that claims 8 and 11 are patentable over May in view of Clark, taken alone or in combination, for at least similar reasons as discussed above identifying deficiencies in the applied references with regard to independent claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection. Furthermore, Applicant submits that claims 2-3, 9-10, and 12-16 which depend directly or indirectly from independent claims 1, 8, and 11 are also patentably distinct from the cited references, taken alone or in combination, for at least similar reasons to those deficiencies discussed above in the cited references with respect to independent claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection.

CONCLUSION

Consequently, the reference(s) cited by this Office Action and/or any previous office action(s) (hereinafter "Office Action(s)") do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any Official Notice that has been taken and/or (mis)characterizations of claims made in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-3 and 8-16, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to any Office Action(s) objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection and/or rejection as to any other claim element(s), any such re-assertion of

remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.